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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/727,984

11/30/2000

Steve Lemke

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10/31/2006

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EXAMINER

PICH, PONNOREAY

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,984

Applicant(s)

LEMKE, STEVE

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/25/2006 has been entered.

Claims 1-6 and 8-22 are pending.

Response to Amendment and Arguments

Applicant's amendments were fully considered. Arguments directed at amended claims were fully considered, but are moot in view of new rejections presented below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borza et al (WO 98/12670) in view of Deo et al (US 6,496,928) and further In view of Rallis et al (US 6,189,099).

Claim 1:

Borza discloses:

1. Gaining access to said computer network by use of a portable computing device (p5, lines 18-24)
2. Reading biometric data peculiar to a user by the use of a biometric data reader coupled to said portable computing device (p8, lines 16-17 and p9, lines 11-15).
3. Comparing said biometric data peculiar to said user to previously biometric data stored in said portable computing device and said computer network for the purpose of identifying the user (p8, lines 1-2, 27-28 and p15, lines 10-25).
4. A remotes station retaining a copy of said biometric data (p8, lines 27-28 and p15, lines 10-25).
5. Denying further access to said computer network if said comparing step fails to identify said user as an authorized user (p15, lines 10-25 and Fig 8, item 40).

Borza does not disclose "wherein said biometric data is operable to be removed from said portable computing device on instruction by a remote station on said computer network". However, Deo discloses a remote station transmitting a programming message to a portable computing device with instructions for the portable computing device to remove authorization data from its memory (col 24, lines 3-17).

The examiner asserts that biometric data as disclosed by Borza is authorization data.

Borza also does not disclose denying further access to said portable computing device if said comparing step fails to identify said user as an authorized user. However,

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Rallis discloses denying further access to a portable computing device if a comparison step fails to identify the user as an authorized user (col 2, lines 27-65).

Therefore, in light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Borza's invention according to the limitations recited in claim 1. One of ordinary skill would have been motivated to incorporate Borza and Deo's teachings with Rallis's invention because Borza's teachings of biometric authentication would allow devices using Rallis's invention to be more secure. Note that Rallis discloses that theft of portable computing devices is a serious problem (col 1, lines 3-5). Replacing the key disclosed by Rallis with biometric authentication as taught by Borza would allow for a user authentication system where the user is unable to forget or lose their key, thus making for a more secure system. One of ordinary skill would have been motivated to incorporate Deo's teachings as Deo discloses that his teachings would allow for a content provider or wireless carrier with the ability to turn off services to individual users of mobile devices (col 28, lines 49-52), which provides efficient subscription management (col 22, lines 47-48). This would allow users of Borza and Rallis's combination invention to disable subscriptions associated with a stolen portable device and associated the subscriptions with another device of the legitimate user's choosing.

Claim 2:

Borza further discloses wherein said access to said computer network is by use of a wireless connection (p7, lines 28-30).

Claim 3:

Borza further discloses said biometric data is a fingerprint (p9, lines 13-15).

Claim 4:

Borza further discloses wherein said biometric data is an iris scan (p11, lines 18-21).

Claim 5:

Borza further discloses wherein said biometric data comprises one or more measured electrical characteristics (p8, lines 13-17).

Claim 6:

Borza does not disclose said biometric data can be programmed into said portable computing device by a remote station on said computer network. However, as mentioned, biometric data is authorization data. Further, Deo discloses authorization data can be programmed into a portable computing device by a remote station on a computer network (col 23, lines 19-24). Therefore, the above limitation is obvious to the combination invention of Borza, Deo, and Rallis.

Claim 8:

Borza discloses:

1. Reading biometric data peculiar to a user (p8, lines 16-17 and p9, lines 11-15).
2. Comparing said biometric data with previously stored biometric data for purpose of identifying the user (p8, line 19-p9 line 2).
3. A remote station retaining a copy of said previously stored biometric data (p8, lines 27-28 and p15, lines 10-25).

4. Preventing access to said computer network if the user is not identified as an authorized user (p15, lines 10-25 and Fig 8, item 40).

Borza does not disclose wherein said previously stored biometric data is operable to be removed from said portable computing device on instructions by a remote station. However, Deo discloses a remote station transmitting a programming message to a portable computing device with instructions for the portable computing device to remove authorization data from its memory (col 24, lines 3-17). The examiner asserts that biometric data as disclosed by Borza is authorization data.

Borza also does not explicitly disclose preventing access to said portable computing device if the user is not identified as an authorized user. However, Rallis discloses preventing access to a portable computing device if the user is not identified as an authorized user (col 2, lines 27-65). Note that as per Rallis's teachings, preventing access to the portable device effectively also denies access to any network that might be connected to via the portable device.

In light of the above, it would have been obvious to one skilled in the art to combine the teachings of Borza, Deo, and Rallis according to the limitations recited in claim 8. One of ordinary skill would have been motivated to combine these teachings for the same reasons discussed in claim 1.

Claim 9:

Claim 9 recites a limitation substantially similar to claim 3 and is rejected for the same reasons.

Claim 10:

Claim 10 recites a limitation substantially similar to claim 4 and is rejected for the same reasons.

Claim 11:

Claim 11 recites a limitation substantially similar to claim 5 and is rejected for the same reasons.

Claim 12:

Claim 12 recites a limitation substantially similar to claim 6 and is rejected for the same reasons.

Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borza et al (WO 98/12670) in view of Deo et al (US 6,496,928).

Claim 13:

Borza discloses:

1. A computer network, said computer network comprising one or more computer workstations (p8, line 27-p9, line 1).
2. A portable computing device, said portable computing device providing wireless access to said computer network (p7, line 27-p8, line 3).
3. A biometric data reading device coupled to said portable computing device (p8, lines 16-17).
4. A data storage device for storing biometric data capable of identifying one and only one user (p8, line 27-p9, line 2).

5. Said one of said one or more workstations retaining a copy of said biometric data (p8, lines 27-28 and p15, lines 10-25).

Borza does not disclose a wireless communication device coupled to said computer network, capable of enabling the loading and removing of said biometric data stored in said portable computing device, and wherein said biometric data is operable to be removed from said portable computing device on instructions by one of said one or more workstations on said computer network.

However, Deo discloses a wireless communication device coupled to said computer network, capable of enabling the loading and removing of authorization data stored in said portable computing device (col 23, lines 19-24 and col 24, lines 3-17), and wherein said authorization data is operable to be removed from said portable computing device on instructions by one of said workstations on said computer network (col 23, lines 19-24).

As per the limitation of "wherein access to said computer network is provided by said one or more workstations upon authentication of biometric data from a user", the limitation describes what the claimed apparatus does. As per MPEP 2114, the patentability of a claimed apparatus depends on its structure, not what it does, thus the limitation does not have patentable weight. Further, note that in the system disclosed by Borza, access to said computer network, i.e. ATM banking network, is provided by said one or more workstation, i.e. ATM banking machine, upon authentication of biometric data from a user (p8, line 27-p9, line 1).

In light of the above, it would have been obvious to one of ordinary skill in the art to have combine Borza and Deo's teachings according to the limitations recited in claim 13. One skilled would have been motivated to incorporate Deo's teachings within Borza's invention because Deo discloses that his teachings would allow for a content provider or wireless carrier with the ability to turn off services to individual users of mobile devices (col 28, lines 49-52), which provides efficient subscription management (col 22, lines 47-48). This would allow Borza more flexible security control over the portable computing devices using his invention including the ability to remotely disable the computing devices if they were stolen.

Claim 14:

Borza further discloses said portable computing apparatus comprises:

1. A bus (Fig 6).
2. A memory unit coupled to said bus (p9, lines 1-2).
3. A data storage device coupled to said bus, capable of storing said biometric data (p9, lines 1-2).
4. A biometric data reader coupled to said bus (p8, lines 16-17).
5. A communication device coupled to said bus for communicating with a computer network (Fig 6, item 19).
6. A processor couple to said bus (Fig 6, item 12), said processor for performing a method for identifying a user by use of said biometric data, said method comprising the steps of:
 - a. Reading applicable biometric data (p3, lines 27-30).

- b. Comparing said biometric data with said biometric data in said memory unit (p3, lines 27-30).

Claim 15:

Borza does not disclose said portable computing apparatus is a personal data assistant (PDA). However, the limitation is obvious to the combination invention of Borza and Deo as Deo discloses portable computing apparatus are personal data assistants (col 1, lines 27-28).

Claim 16:

Borza further discloses said biometric data reader is implemented as part of the portable computing apparatus (p8, lines 16-17).

Claims 17 and 18:

Claims 17 and 18 recite limitations substantially similar to claims 3 and 4 respectively and are rejected for the same reasons.

Claim 19:

Borza further discloses said biometric data is any electronically storable identifying biometric data (p8, lines 13-17).

Claim 20:

Claim 20 is substantially similar to claim 5 and is rejected for the same reasons.

Claim 21:

Borza further discloses said computer network further comprises a remote station connected to said computer network (p8, lines 19-20 and line 29-p9, line 1).

Claim 22:

Borza further discloses wherein said remote station is for performing a method of network access control (p8, lines 27-29). Borza further discloses said method comprising uploading said biometric data from said portable computing apparatus (p8, lines 19-20). Borza does not disclose said method comprising:

1. Downloading said biometric data to said portable computing device.
2. Erasing said biometric data from said portable computing apparatus.

However, the examiner asserts that biometric data is authorization data. Further, Deo discloses downloading authorization data to a portable computing apparatus and erasing authorization data from a portable computing apparatus (col 23, lines 19-24 and col 24, lines 3-17). Therefore, the above limitations not met by Borza are obvious to the combination invention of Borza and Deo.

It is further noted that the limitations recited in claim 22 describes what the claimed apparatus does, thus as per MPEP 2114, the limitations do not have patentable weight and claim 22 is rejected for the same reasons given in claim 21.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

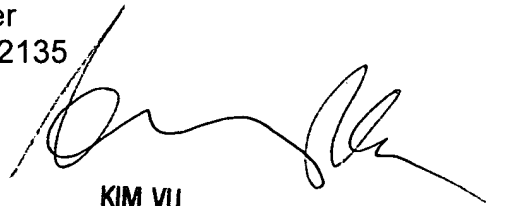
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

Ponnoreay Pich
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Art Unit 2135



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